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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,131	06/24/2003	Bohumil Pergl	J400-003 CIP	1600
21706	7590	11/14/2005	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			CHEN, TIANJIE	
			ART UNIT	PAPER NUMBER
			2652	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/602,131	PERGL, BOHUMIL <i>[Signature]</i>
	Examiner	Art Unit
	Tianjie Chen	2656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### ***Non-Final Rejection***

#### ***Claim Objections***

1. Claim 6 is objected to because of the following informalities:

In claim 6, line 3; "an" should be changed to --a--.

Appropriate correction is required. )

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
3. Claims 1, 6, and 8 recite "A compact disc of circular and non-circular shape." A disc cannot be circular shape and also non-circular shape. Therefore, it is impossible for a disc is "circular and non-circular shape." One skilled in the art to which it pertains, or with which it is most nearly connected is unable to make and/or use the invention.

The rest claims are rejected for their dependence from claims 1, 6, and 8, respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson (US 5,982,736) in view of Schroeder et al (US 5,791,990).

Claim 1, Pierson shows a compact disc in Figs. 1-5 (Column 5, line 11) of non-circular shape in Figs. 1-4 including: disc body having a central annular portion 37 and recording portion 21 (Fig. 4); recording layer 21 (Column 5, lines 25-28) and reflective layer 24 (Column 5, line 59-61) provided on the recording portion of disc body and covered by a protective coating 26 (Column 6, line 10); a basic cover paint 29 (Column 6, lines 16-20) applied to the annular portion.

Pierson does not show at least one defined area with a border and central portion situated in the annular recording portion containing a hidden printing, a scratch-off coating covering the defined area.

Schroeder et al teaches a compact disk (Column 3, lines 25) can be used for different media (Column 4, lines 29-30), which includes at least one defined area 240 (Fig. 5A) with left border and right border and central portion situated between the left and right borders containing a hidden printing (activation cod); and a scratch-off coating 220 (Fig. 5A; column 7, line 58) covering the defined area.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to apply Schroeder et al's scratch-off figure into Pierson's

device. The rationale is as follows: Pierson's disc is an optical disc, which can be used for game (Column 1, lines 28-29). Schroeder et al's design is used for decrease the possibility of fraud (Column 2, lines 59-60) for games (Column 4, lines 36-38). One of ordinary skill in the art would have been motivated to apply Schroeder et al's scratch-off printing into Pierson's disc for reducing possibility of fraud.

Claim 5, Schroeder et al shows the scratch-off paint coating in Fig. 5 bears activation code, which guides user for activating computer, which is a guidance printing.

5. Claims 2, 3, 6, 8-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson in view of Schroeder et al as and Schaefer et al (US 5,992,892).

Claim 6, the above described Pierson and Schroeder et al's device includes a compact disc of non-circular shape including: a disc body having central annular portion and a recording portion; a recording and reflective layer provided on the recording portion of the disc body and covered protective coating; a basic cover paint applied the annular portion; at least one defined area with border and central portion situated in the annular recording portion above the basic cover paint 29 and containing a hidden printing.

Claims 2 and 6; Schroeder et al does not show the detailed structure of the scratch-off layer.

Schaefer et al shows scratch-off printing in Fig. 5, wherein the defined area printing (the "Game Play Data") is separated from the scratch-off paint ("Scratch Off Coating") by a translucent interlayer ("clear varnish Release Layer") (Claim 2), and

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which has a translucent interlayer coating (clear varnish release layer) covering the defined area; and a scratch-off paint coating applied to the interlayer coating (Claim 6). Since Schroeder et al does not show the way of making the scratch-off structure. Schaefer shows how to workable structure for the scratch-off element. One of ordinary skill in the art would have been motivated to apply Schaefer et al's structure in to Schroeder et al's device for making it workable.

Claims 8 and 9, the above constructed Pierson, Schroeder et al, and Scheafer et al's device is a compact disc of non-circular shape including: an optically readable disc body having a central annular portion and a recording portion; a recording and a reflective layer provided on the recording portion of the disc body and covered by a protective coating; a basic cover paint having a basic printing applied to the annular portion; at least one defined area with a border and central portion situated in the annular or recording portion above the basic paint containing a hidden printing; a scratch-off paint coating covering the defined area; and a means (translucent interlayer), which separated the defined area from the scratch-off paint for protecting the hidden printing when applying and removing the scratch-off paint.

Claims 3 and 10, Applicant does not disclose unexpected result for setting the particular 2 mm, not 2.5 or 1.5 mm. One of ordinary skill in the art would determine how much should be the width, by which the interlayer coating overlaps the border portion of the defined area. Scheafer et al shows in Fig. 5 that the interlayer overlaps the whole area of the defined area. Pierson shows the width of the card is 3.5 inches = 89 mm (Column 8, lines 11-14). Schroeder et al shows that the scratch-off area 220 has a width, which is more than one half of the card. One or ordinary skill in the art

would have been reasonably expecting that the width of the defined area is more than 50 mm. The interlayer would overlap the border more than 2 mm.

Claim 12, Schroeder et al shows the scratch-off paint coating in Fig. 5 bears activation code, which guide user to activate computer, which is guidance printing.

Claim 13, Pierson shows that the basic printing is directly applied to the annular portion.

Claim 14, Pierson shows that only one reflective layer is provided on the recording portion of the disc body.

6. Claims 4, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson in view of Schroeder et al and Scheafer et al as applied to claim 3 and 6 above, and further in view of Otani et al (JP 11-238262A).

With regard to claim 7, the above Pierson, Schroeder et al, and Scheafer et al device shows that the translucent interlayer overlaps the border portion of the defined area by at least 2 mm.

With regard to claims 4, 7, and 12; Schaefer et al does not show the thickness of the interlayer.

Otani et al teaches an interlayer having a thickness of 40-50 microns, which can be well adhered ([0013] and SOLUTION). One of ordinary skill in the art would have been motivated to apply this thickness for being well adhered.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

8. The prior art made of record in PTO-892 Form and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is 571-272-7570. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TIANJIE CHEN  
PRIMARY EXAMINER